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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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DIGIMARC CORPORATION
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EXAMINER

MACKOWEY, ANTHONY M

ART UNIT PAPER NUMBER

2623

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/029,229	Applicant(s) MCKINLEY ET AL.	
	Examiner Anthony Mackowey	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-22 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-22 and 24-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

The amendment filed May 9, 2005 has been entered and made of record.

Applicant's arguments filed May 9, 2005 have been fully considered but they are not persuasive.

On pages 7, line 18 thru page 8, line 11, applicant presents arguments regarding the rejection of claim 18 in view of Ogasawara and Yamaguchi's teachings. Applicant's arguments focus primarily on the graphic displayed by Ogasawara. Applicant recites col. 22, lines 19-21 of the reference, in which the graphic is described as a barcode representing the weight of a bag of potatoes. Referring to the rejection of claim 18 in the previous office action (pages 4, line 20-page 6, line 5), the Examiner did not rely upon the Ogasawara reference to show the contents of the graphic. The Ogasawara reference was cited for teaching an image sensor apparatus capable of capturing a graphic displayed on a display screen, and portable device capable of displaying graphics, not the details of the graphic being displayed. The Yamaguchi reference was relied upon to teach steganographically encoded graphics. Further, the claims do not limit the reference from any personal or confidential scope as described by the examiner, but as broadly set forth in the claim, the graphics and encoded information can be anything, even potatoes and their weight.

On page 8, lines 12-20, with regard to the rejection of claims 19 and 20, applicant argues that the obviousness for combining Ogasawara and Yamaguchi is derived from

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the applicant's own disclosure. Examiner directs applicant's attention to Yamaguchi, col. 3, lines 45-49. Yamaguchi teaches the image can be a person's face such as that on an identity card, thus it is obvious a similar graphic displayed on a portable device would allow the device to be used analogously as a form of identification. Examiner's reasoning was drawn from Yamaguchi's teaching of the graphic as part of an identification card, not applicant's disclosure. Furthermore, applicant's disclosure presents the graphics and encoded information as a means to access personalized websites and promotional material. Page 8, lines 18-23 discuss the image of the owner watermarked with information to serve as a business card to be transmitted to another person but does not specifically identify the graphic and encoded information as a proof of ownership of the device.

With regard to claims 24-27, the Examiner has shown the rejections of claims 18-20 are not deficient as discussed above. The arguments presented above are also applicable to claims 24-27.

With regard to arguments presented for claims 21 and 22, applicant is again referring to features of the Ogasawara reference that were not relied upon in forming the rejection, specifically the produce weighting scale. The limitation being addressed is using the image sensor apparatus to capture a representation of a graphic presented on the display screen of the portable device. In the rejection of claim 18, the Examiner had already addressed that many portable devices (including wristwatches) had display screens capable of displaying graphics that could be captured by the imaging apparatus taught by Ogasawara. Ogasawara further teaches that the information can be captured

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from almost any form of display screen (col. 22, lines 59-62), thus not limiting it to a display on a scale. With regard to the obviousness and motivation for the portable device being a wristwatch, loss and theft of portable devices is a well-known concern in the consumer market in which the belt-clip and portable phone or PDA pocket in clothing, bags and other goods has become widely used.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-20, 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U.S. Patent 6,512,919 to Ogasawara and U.S. Patent 6,438,251 to Yamaguchi.

As to claim 18, Ogasawara discloses a method (col. 4, lines 58-61, The detailed description sets for the sequence of steps for operating the invention in connection with the illustrated embodiment), employing an image sensor apparatus (col. 15, line 68; col. 16, lines 47-49, Ogasawara teaches a digital image capture device such as a CCD camera system) and a separate device with a display screen (col. 22, lines 1-4, 19-21, Ogasawara teaches the system is particularly useful applications in which information is displayed on an LCD display screen.), comprising using the image sensor apparatus to capture a representation of a graphic presented on the display screen of the device (col.

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22, lines 59-63, Ogasawara teaches information is captured by placing the information within the visual image field of the system's digital camera.), and decoding said captured representation (col. 21, lines 18-20, Ogasawara teaches a program decodes the bar code image data.)

Ogasawara teaches capturing the image display of a small LCD display (col. 22, lines 19-26) but does not disclose the device with the display screen presenting the graphic as being portable. However, Ogasawara teaches the image capturing device is part of a wireless videophone (col. 15, lines 63-67), this videophone has a graphics display implemented as an LCD display (col. 16, lines 40-41). Ogasawara also teaches that information can be captured from almost any form of display means (col. 22, lines 59-62). The examiner takes Official Notice that portable devices such as PDA's (personal digital assistants), mobile phones, digital wristwatches or electronic pocket organizers commonly have display screens capable presenting graphics and/or alpha-numeric characters, therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the graphic presented on the display screen of a portable device.

Ogasawara does not disclose obtaining plural-bit data steganographically encoded in the graphic. Yamaguchi discloses a method of invisibly embedding additional information into a main image (col. 3, lines 44-49) and a recovery operation to reproduce the embedded additional information (col. 4, lines 30-35). The teachings of Ogasawara and Yamaguchi are combinable because they both involve capturing and decoding images to obtain additional information. It would have been obvious to one of

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ordinary skill in the art at the time the invention was made to have the steganographically encoded graphic of Yamaguchi, displayed, captured, and decoded as taught by Ogasawara. One would have been motivated to do so as it would allow a person to receive or send information to a desired location or party without obvious exposure of personal or financial information and provide an effective measure against unauthorized copying, forgery and tampering of the graphics (Yamaguchi, col. 1, lines 20-26).

As to claims 19 and 20, Ogasawara does not disclose the graphic comprises an image of a person or a proprietor of the portable device. However, Yamaguchi teaches the main image into which additional information is embedded may be a photograph of a person's face on an identification card (col. 3, lines 45-49). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the graphic comprise an image of a person or more specifically an image of a proprietor of the portable device because the device could be used as a form of personal identification, authorization or proof of ownership of the portable device.

As to claim 24, a method Ogasawara discloses a method (col. 4, lines 58-61, The detailed description sets for the sequence of steps for operating the invention in connection with the illustrated embodiment) employing an image sensor apparatus (col. 15, line 68; col. 16, lines 47-49, Ogasawara teaches a digital image capture device such as a CCD camera system), and a separate device with a display screen (col. 22, lines 1-4, 19-21, Ogasawara teaches the system is particularly useful applications in which information is displayed on an LCD display screen.), comprising using the image sensor

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apparatus to capture a representation of a graphic presented on the display screen of the device (col. 22, lines 59-63, Ogasawara teaches information is captured by placing the information within the visual image field of the system's digital camera.), and decoding plural bit-machine readable information also represented on the display screen (col. 21, lines 18-20, Ogasawara teaches a program decodes the bar code image data.).

Ogasawara teaches capturing the image display of a small LCD display (col. 22, lines 19-26) but does not disclose the device with the display screen presenting the graphic as being portable. However, Ogasawara teaches the image capturing device is part of a wireless videophone (col. 15, lines 63-67), this videophone has a graphics display implemented as an LCD display (col. 16, lines 40-41). Ogasawara also teaches that information can be captured from almost any form of display means (col. 22, lines 59-62). The examiner takes Official Notice that portable devices such as PDA's (personal digital assistants), mobile phones, digital wristwatches or electronic pocket organizers commonly have display screens capable presenting graphics and/or alphanumeric characters, therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the graphic presented on the display screen of a portable device.

Ogasawara does not disclose the graphic includes a depiction of a proprietor of the portable device. However, Yamaguchi teaches the main image into which additional information is embedded may be a photograph of a person's face on an identification card (col. 3, lines 45-49). It would have been obvious to one of ordinary skill in the art at

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the time the invention was made to have the graphic comprise an image of a person or more specifically an image of a proprietor of the portable device because the device could be used as a form of personal identification, authorization or proof of ownership of the portable device.

Claim 25 is substantially claim 18 with the exclusion of decoding the plural bit information. Arguments analogous to those presented in claim 18 above are applicable to claim 25.

As to claim 26, the arguments with regard to decoding the plural bit information presented above in claim 18 are applicable to claim 26.

As to claim 27, arguments analogous to those presented for claims 19 and 20 are applicable to claim 27.

Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U.S. Patent 6,512,919 to Ogasawara and U.S. Patent 6,438,251 to Yamaguchi as applied to claims 18 above, and further in view of U.S. Patent 6,359,837 to Tsukamoto.

The combination of Ogasawara and Yamaguchi does not disclose the portable device is also used display the current time or the portable device being a wristwatch. Tsukamoto discloses a wristwatch with a display that can display the current time and an image (col. 1, lines 58-63). It would have been obvious to one of ordinary skill in the art at the time the invention was made have the graphic displaying device of the combination of Ogasawara and Yamaguchi be a wristwatch as taught by Tsukamoto because a wristwatch is one of the most common accessories worn by people and is

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securely fastened around a persons wrist thus preventing loss and theft, further protecting information embedded within the graphic. People's concern over losing their portable devices is well known and

Conclusion

The art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPAP 2002/0023027 to Simonds is cited for teaching a portable display device displaying a barcode to be captured.

USPAP 2005/0085188 to Ishii et al. is cited for teaching optical communication between mobile communication devices. The devices display graphics which are captured and processed by the other communication device.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Mackowey whose telephone number is (571) 272-7425. The examiner can normally be reached on M-F 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jingge Wu can be reached on (571) 272-7429. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AM
8/5/2005


JINGGE WU
PRIMARY EXAMINER